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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of	:
Behan	:Decision on Petition
Serial No.: 10/668,035	:
Filed : 22 September 2003	:
Attorney Docket No.: AREN-005CON	:

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on 31 May 2011 requesting reconsideration of the restriction requirement mailed 13 May 2010.

BACKGROUND

This application was filed as a national application under 35 U.S.C. 111(a) and as such is entitled to restriction practice under Chapter 800.

On 29 June 2006, the examiner set forth a restriction requirement which divided claims 1-19 into six groups.

On 20 December 2006, applicants elected Group V, claims 1-4 and 8-16, with traverse.

On 10 April 2007, the examiner considered the traversal and made the restriction requirement final. Claims 5-7 and 8-15 were withdrawn from consideration under 37 CFR 1.42(b).

On 24 January 2008, the examiner mailed a second non-final action in which claims 1-3, 8-10 and 20-21 were examined on the merits. These claims were then finally rejected on the merits in an Office action mailed 15 December 2008. Dependent claim 8 is shown below.

> 8. (Currently amended) The method of claim 1 wherein said orphan receptor is selected from the group consisting of: GPR3 (SEQ ID NO:46), GPR4 (SEQ ID NO:60), GPR6 (SEQ ID NO:47), GPR12 (SEQ ID NO:48), GPR21 (SEQ ID NO:50), OGR1 (SEQ ID NO:27), GHSR (SEQ ID NO:45), RE2 (SEQ ID NO:23) and ALO22171 (SEQ ID NO:49).

On 9 March 2010, the examiner mailed applicants a miscellaneous action requiring applicants to elect an orphan GPRC from dependent claim 8 in response to the restriction requirement dated 20 December 2006.

On 13 May 2010, in a second restriction requirement, the examiner divides the already examined claims up into 9 groups depending upon the SEQ ID NO of the orphan receptor agonist recited in dependent claim 8.

On 11 November 2010, applicants elected Group I, GPR3 (SEQ ID NO 46) with traverse. Claim 9 was then withdrawn from consideration as being directed to a non-elected invention. Claims 1-3, 8-10 and 20-25 were examined on the merits. Claims 1-3, 8, 10, 20, 21 and 23-25 were objected to for reciting non-elected orphan GPCRs.

On 31 May 2011, applicants filed a response along with this petition.

DISCUSSION

The file history of the instant application has been considered carefully.

The petition points out that the examiner has placed Markush claims into groups for the purposes of restriction. Because applicant's claims are drafted in Markush-type format, the petition argues that they should be considered under the guidelines of MPEP 803.02. This is persuasive.

Further, it is noted that on 9 February 2011, the Office issued A Federal Register Notice entitled "Supplemental Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for treatment of Related Issues in Patent Applications." Page 7166 sets forth guidelines for the treatment of Markush-type claims:

> "Under principles of compact prosecution, the examiner should also require the applicant to elect a species or group of indistinct species for search and examination (i.e., an election of species). If the examiner does not find the species or group of indistinct species in the prior art, then the examiner should extend the search to those additional species that fall within the scope of a permissible Markush claim. In other words, the examiner should extend the search to the species that share a single structural similarity and a common use. The improper Markush claim should be examined for patentability over the prior art with respect to the elected species or group of indistinct species, as well as the species that share a single structural similarity and a common use with the elected species or group of indistinct species (i.e., the species that would fall within the scope of a proper Markush claim)."

In view of these new guidelines, the restriction requirement between the embodiments of the Markush claims is unwarranted and is hereby replaced with a provisional election of species requirement.

Further, applicant has argued that the examiner has not followed the election and examination practice for Markush claims. MPEP 803.02 requires extended examination of other embodiments. See:

> Following election, the Markush-type claim will be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim is not allowable, the provisional election will be given effect and examination will be limited to the Markush-type claim and claims to the elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration.

Lastly, it is noted that the examiner has objected to claims for reciting non-elected subject matter. This is counter to MPEP 803.02, which permits applicants to retain non-elected subject recited in the alternative of a Markush claim. It is noted that MPEP 809 also permits generic claims to encompass non-elected species.

DECISION

For these reasons, the petition filed under 37 CFR 1.144 on 31 May 2011 is **GRANTED** as follows.

The intraclaim restriction requirement set forth on 13 May 2010 requiring applicants to elect a single GPCR of Markush claim 8 has been withdrawn and replaced with an election of species requirement. The elected GPR3 (SEQ ID NO 46) will continue to be the starting place for examination.

The objection to claims for reciting non-elected subject matter has been withdrawn.

The application will be forwarded to the examiner to consider the papers filed 31 May 2011 in a manner consistent with this petition decision. Markush claims are to be examined according to the guidance in MPEP 803.02 and the FR Notice. Generic claims will be examined according to MPEP 809.

Should there be any questions regarding this decision, please contact Quality Assurance Specialist Julie Burke by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0512 or by Official Fax at 703-272-8300.

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